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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* MARWAN ZEBIAN

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Appeal 2008-004763
Application 09/774,968[1]
Technology Center 2400

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Decided: July 31, 2009[2]

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Before LEE E. BARRETT, CAROLYN D. THOMAS, and
STEPHEN C. SIU, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Filed January 31, 2001, titled "Intelligent Autodialer," which claims the benefit of Provisional Application 60/181,612, filed February 10, 2000.

[2] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-25 and 30-32. Claims 26-29 and 33-40 have been canceled. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

We affirm-in-part.

## STATEMENT OF THE CASE

*The invention*

The invention relates to maximizing qualities of a user network access number (NAN) list used for connecting to an online service provider (OSP). A NAN may be telephone number. It is stated that an individual has no reasonable means to determine which of the available NANs is the most effective in terms of quality of connection; instead, users have to learn through experience which are good and bad. Spec. ¶ [0011].

In accordance with the invention, a sequence for a client device to select NANs from a user NAN list is based upon information provided by the OSP and provided to the client device. NANs are selected from the user NAN list based upon quality of a back end connection and/or cost of a back end connection. Spec. ¶¶ [0013]-[0014].

*Representative claims*

Claims 1 and 12 are reproduced below:

> 1. A method for maximizing qualities of a user network access number (NAN) list, the user NAN list comprising plural NANs, the NANs for use by a user's client device in connecting to a data network under control of a server system, the method comprising
>
> storing in the server system an available NAN list of NANs available for the client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list

storing in the server system connection information about connecting from the NANs in the available NAN list to the data network

connecting the client device to the server system

setting the NANs in the user NAN list based upon the available NAN list

setting an order for selecting the NANs in the user NAN list based upon the connection information, wherein the order is set outside of the user' s control

disconnecting the client device from the server system.

12. A method of setting an order for using network access numbers (NANs) in a user NAN list, the user NAN list comprising plural NANs, the NANs for use by the user' s client device in connecting to a data network under control of an online service provider server system, wherein a connection from the client device to the data network comprises a front end portion and a back end portion, the front end portion comprising a first connection from the client device to a public switch, and the back end portion comprising a second connection from the public switch to a point of presence under control of one of plural back end providers plus a third connection from the point of presence to the data network, wherein authorization for the back end provider to establish the back end portion is by the online service provider server system, and each NAN is associated with one of the back end providers, the method comprising

storing in the online service provider server system an available NAN list of NANs available for the user's client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list

storing in the online service provider server system connection information for connecting from the NANs in the available NAN list to the data network, the connection information comprising at least one of (a) quality of connection information for the back end portion and (b) costs information for the back end portion

establishing a connection from the client device to the online service provider server system

transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system

setting an order for selecting the NANs in the user NAN list based upon at least one of (a) the stored quality of connection information for the back end portion and (b) costs information for the back end portion.

*The references*

| | | |
|---|---|---|
| West | US 6,081,508 | June 27, 2000 (filed Feb. 25, 1998) |
| Dieterman | US 2002/0013896 A1 | Jan. 31, 2002 (effective filing date May 10, 1999) |

*The rejections*

Claims 1-11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by West.

Claims 12-25 and 30-32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over West and Diederman.[3]

[3] The Examiner's Answer refers to claims 12-40. Ans. 16. However, claims 26-29 and 33-40 have been canceled. Br. 2.

## DISCUSSION

*Procedural matters*

Due to various deficiencies in format, Appeal Briefs were filed on December 13, 2004, and May 3, 2006, and a Substitute Appeal Brief was filed on June 25, 2007. Reply Briefs were filed on March 16, 2005, and July 18, 2006. Examiner's Answers were entered on March 4, 2005, June 1, 2006, and April 20, 2007. This opinion refers to the Substitute Appeal Brief filed June 25, 2007 (Br.), the Examiner's Answer entered April 20, 2007 (Ans.), and the Reply Brief filed July 18, 2006 (Reply Br.).

In the Examiner's Answer, the Detailed Action (unnumbered page 3 through page 36 (actually page 38, since the first two pages of the Answer are not numbered)) is repeated from the Final Office Action entered September 8, 2004, including the statement that the action is final (Ans. 35, actually 37), which may be the reason the page numbers are off. We refer to the page numbers on the page rather than the actual page number. The Response to Arguments in the Detailed Action (unnumbered page 3 to Ans. 11) refers to arguments in Appellant's response of June 25, 2004, before the Final Office Action. The Examiner's responses to the arguments in the Appeal Brief are found at pages 36-44 of the Answer.

*Principles of law*

*Anticipation*

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim. A prior art disclosure that 'almost' meets that standard may render the claim invalid

under § 103; it does not 'anticipate.'" *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983) (internal citations omitted).

*Obviousness*

For an obviousness rejection, the combination of references must teach or suggest to a person of ordinary skill in the art all of the claim limitations. 35 U.S.C. § 103(a).

*Arguments not made are waived*

Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) ("Any arguments or authorities not included in the brief or a reply brief . . . will be refused consideration by the Board, unless good cause is shown."); *In re Watts*, 354 F.3d 1362, 1367 (Fed. Cir. 2004) ("Just as it is important that the PTO in general be barred from raising new arguments on appeal to justify or support a decision of the Board, it is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board." (Footnote omitted.)).

*Facts - relevant contents of West*

West teaches that when a remote user has a choice of multiple access methods and telephone numbers for connecting to a local computer or local area network (LAN), the user may have the problem of knowing what numbers and access methods the user has a choice of, and knowing the cost of using those numbers or access methods. Abstract.

West teaches that "[d]istributing, storing, and searching a comprehensive directory of access numbers and associated costs would, in general, be prohibitive on remote computers with limited storage and

computation capacity, such as portable computers typically often used by mobile workers." Abstract.

West describes that a remote computer 100 is connected to a corporate communication system 140 via a path using the public switched telephone network (PSTN) 120 either through an Internet point of presence (POP) 320, as shown in Figure 3, or directly, as shown in Figure 4. The system 140 has a LAN 340 and a management server 334. Figures 3 and 4.

West teaches:

> In anther [sic] aspect of the invention, in general, the invention provides software for causing a computer, such as a *management server, to store a dialing database, including telephone access numbers for access paths*, and establish an authenticated management communication path between the computer and a remote computer. The computer then provides information from the dialing database to a remote computer, for use on the remote computer in selecting an access path between the remote computer and a computing resource.

Col. 3, ll. 36-45 (emphasis added).

West describes that management server 334 sends only a portion of the master client access database to a remote computer. West teaches that access 550 on the remote computer retrieves the user-specific information from a local database 552, "which contain a *portion* of the data stored in master client database 722 (FIG. 7) stored on management server 334 (FIG. 3)." Col. 12, ll. 51-53 (emphasis added). West also describes that "[i]n response to a request from access 550 (FIG. 5) executing on remote computer 100, access server provider 720 sends *relevant portions* of master client database 722 or corporate database 774 to the remote computer. Access 550 stores those received *portions* in local database 552 on remote computer 100." Col. 17, ll. 39-44 (emphasis added).

West describes that the "list [at the remote computer] is sorted so that the first entry in the list is the path preferred by the connection software. Preference is based on a calculated cost for each of the paths, including both monetary and performance related factors." Col. 6, ll. 44-48. The order may be determined at the remote computer, col. 12, ll. 59-62, or the management server (col. 13, ll. 31-39).

*Anticipation*

Appellant argues four issues with respect to independent claim 1.

1.

*Issue 1*

Has Appellant established that the Examiner erred in finding that West teaches "storing in the server system an available NAN list of NANs available for the client device to connect to the data network"?

*Contentions*

The Examiner finds that the client device corresponds to the remote computer 100, the data network corresponds to LAN 340, and the server system storing an available NAN list corresponds to the management server 334 in Figure 4, referring to column 3, lines 35-45. Final Rej. 14.

Appellant argues that the computer 100 and LAN 340 are apparatuses and do not teach the claimed storing step. Br. 5.

The Examiner responds that the management server 334 is a server, which communicates with a master client database 722, which includes data needed to select a lowest cost connection path, referring to column 11, ll. 38-47. Ans. 37.

The Examiner responds (Ans. 37-38) that West teaches "software for causing a computer, such as a *management server, to store a dialing database, including telephone access numbers for access paths*, and establish an authenticated management communication path between the computer and a remote computer." Col. 3, ll. 36-45 (emphasis added)).

Appellant does not reply to the Examiner's reasoning in the Reply Brief.

*Analysis*

We agree with the Examiner that column 3, lines 36-45, of West teaches that the management server 334 stores a dialing database of telephone access numbers or NANs. For the server to store the dialing database, there must inherently have been a step of storing the numbers. Accordingly, Appellant has not shown error in the Examiner's finding that the limitation is taught by West.

*Conclusion - Issue 1*

Appellant has not established that the Examiner erred in finding that West teaches "storing in the server system an available NAN list of NANs available for the client device to connect to the data network."

2.

*Issue 2*

Has Appellant established that the Examiner erred in finding that West teaches "wherein the user NAN list comprises a subset of the available NAN list"?

*Contentions*

The Examiner finds that West teaches that the user NAN list comprises a subset of the available NAN list on the management server 334 at column 3, lines 35-45. Final Rej. 14.

Appellant argues that the cited portion of West does not disclose a user NAN list that is a *subset* of the available NAN list. Br. 5.

The Examiner states that management server 334 stores an available NAN list, and the user may select from a "calling to" field, where the choices are in part preconfigured into the system by an administrator of the system, referring to column 6, lines 8-22 and 37-48. Ans. 38.

Appellant does not reply to the Examiner's reasoning in the Reply Brief.

*Analysis*

The Examiner's reasoning about a "calling to" field does not address the "subset" language, because the "calling to" field could possibly include the complete list of available NANs.

Nevertheless, West describes that "[d]istributing, storing, and searching a comprehensive directory of access numbers and associated costs would, in general, be prohibitive on remote computers with limited storage and computation capacity, such as portable computers." Abstract. Thus, West teaches that there would be a problem for a user NAN list to be as comprehensive as the available NAN list. West describes that access 550 on the remote computer retrieves the user-specific information from a local database 552, "which contain a *portion* of the data stored in master client database 722 (FIG. 7) stored on management server 334 (FIG. 3)." Col. 12,

ll. 51-53 (emphasis added). West also describes that "[i]n response to a request from access 550 (FIG. 5) executing on remote computer 100, access server provider 720 sends *relevant portions* of master client database 722 or corporate database 774 to the remote computer. Access 550 stores those received *portions* in local database 552 on remote computer 100." Col. 17, ll. 39-44 (emphasis added). Accordingly, we find that West describes that the user NAN list on the remote computer is a subset (a portion of) the available NAN list. Appellant is responsible for reading and understanding the entire reference. Thus, Appellant has not shown error in the Examiner's finding that the limitation is taught by West.

*Conclusion - Issue 2*

Appellant has not established that the Examiner erred in finding that West teaches "wherein the user NAN list comprises a subset of the available NAN list."

3.

*Issue 3*

Has Appellant established that the Examiner erred in finding that West teaches "storing in the server system connection information about connecting from the NANs in the available NAN list to the data network"?

*Contentions*

The Examiner finds that the step is taught at column 3, lines 5-7 and 35-35, where the management server 334 stores a "set of access paths" which correspond to "connection information." Final Rej. 14.

Appellant argues:

> A corporate communication system and a list of telephone access numbers stored in a management server do not teach the feature "storing in the server system connection information about connecting from the NANs in the available NAN list to the data network." The recited "connection information" includes the cost of the back end connection as well as the quality of the back end connection. Storing a list of telephone access numbers is not the same or analogous to storing cost and quality information about each NAN in an available NAN list.

Br. 6.

The Examiner notes (Ans. 40) that West teaches: "Master client database 722 includes data needed to select a lowest cost connection path from a remote computer 100." Col. 1, ll. 46-47. The Examiner further notes (Ans. 40) that West teaches:

> In response, as indicated in FIG. 2(c), possible communication paths identified by the connection software to couple remote computer 100 and the selected access point within corporate communication system 140 are presented in a list of connection paths 232. The list is sorted so that the first entry in the list is the path preferred by the connection software. Preference is based on a calculated cost for each of the paths, including both monetary and performance related factors.

Col. 6, ll. 40-48. Thus, the Examiner finds the management server 334 is providing the stored NAN list based on connection information stored on the server. Ans. 40.

*Analysis*

Claim 1 does not recite what kind of "connection information" is stored in the server system. Appellant's argument that "[t]he recited 'connection information' includes the cost of the back end connection as well as the quality of the back end connection" (Br. 6) refers to unclaimed

limitations. Appellant clearly knows how to claim that the connection information includes costs and quality information as evidenced by the limitations in claim 12. Limitations will not be read into the claim.

Nevertheless, West describes that the connection information can be based on monetary and performance factors. In addition to the statement at column 6, West describes that "NPA [area code] tables 1200, POP table 1230, and ISP table 1240, together termed the dialing tables, are computed at management server 334 and transferred to remote computer 100 at the request of access 550 [on the remote computer]." Col. 16, ll. 44-47. Thus, connection information is stored at the server and transferred to the remote computer. West describes:

> The monetary and performance factors stored in records of ISP table 1240 and POP table 1230 are numbers that represent a level for each factor. Examples of monetary factors include the charge to initiate a connection through an ISP, and a per hour usage charge. . . . Examples of performance factors include a speed factor which is a higher number for slow data rate connections, a delay factor which is a high number for connections that suffer high latency in delivery of packets, and an error factor which is high if a large number of data packets are lost in transmission. In other words, the monetary and performance factors enable one to computer a relative cost associated with using a particular POP. Note that both the POP and the ISP can have performance factors associated with them.

Col. 15, l. 55, to col. 16, l. 9. Thus, the connection information is based on cost and performance (quality) criteria.

Thus, Appellant has not shown error in the Examiner's finding that the limitation is taught by West.

*Conclusion - Issue 3*

Appellant has not established that the Examiner erred in finding that West teaches "storing in the server system connection information about connecting from the NANs in the available NAN list to the data network."

4.

*Issue 4*

Has Appellant established that the Examiner erred in finding that West teaches "setting an order for selecting the NANs in the user NAN list based upon the connection information, wherein the order is set outside of the user' s control"?

*Contentions*

The Examiner refers to column 2, lines 58-63, for a list of connection information whose order is set outside the user's control. Final Rej. 14.

Appellant argues that determining a set of access paths at column 2 does not teach or suggest "*setting an order* for selecting the NANs in the user NAN list *based upon the connection information, wherein the order is set outside of the user's control.*" Br. 6.

The Examiner finds that West teaches that the management server 334 is providing the stored NAN list to the remote user based on connection information also stored on the server, referring to column 6, lines 40-48. Ans. 41.

Appellant argues that the Examiner did not contest Appellant's argument that column 2, lines 58-63 of West does not teach "setting an order for selecting the NANs in the user NAN list based upon the connection information, wherein the order is set outside of the user's control," and

therefore, it must be concluded that the Examiner agreed with Appellant and the rejection must be reversed. Reply Br. 2.

*Analysis*

Initially, we do not agree that the Examiner conceded that West does not teach the limitation in question because the rejection is maintained.

As pointed out by the Examiner, West describes that the list of connection paths is sorted based on preference, where "[p]reference is based on a calculated cost for each of the paths, including both monetary and performance related factors." Col. 6, ll. 46-48. Thus, West describes setting the order based upon connection information.

The claim limitation does not recite where the step of "setting the order" takes place. West describes that the order may be determined at the remote computer (col. 12, ll. 59-62) or the management server (col. 13, ll. 31-39). Thus, the order is set without user control. West discloses that "a user may be given the right to reorder the list" (col. 6, ll. 53-54), but this does not affect the fact that the list is set without user control.

Thus, Appellant has not shown error in the Examiner's finding that the limitation is taught by West.

*Conclusion - Issue 4 and final conclusion*

Appellant has not established that the Examiner erred in finding that West teaches "setting an order for selecting the NANs in the user NAN list based upon the connection information, wherein the order is set outside of the user's control."

The rejection of claims 1-11 under 35 U.S.C. § 102(e) over West is affirmed.

*Obviousness*

*Claims 30-32*

Claim 30 is similar to claim 1 except that it recites an "online service provider server system" instead of a method as in claim 1. The Examiner cites to Dieterman to show connection to a service provider. Appellant does not challenge this aspect of the rejection, and indeed, West discloses that the system may be used with POPs and ISPs. Appellant argues that claim 30 should be patentable for the same reasons as claim 1. Br. 8. Since we affirm the rejection of claim 1, the rejection of claim 30 and its dependent claims 31 and 32 are also affirmed for the same reasons.

*Claims 12-25*

Appellant argues two issues with respect to independent claim 12. These issues involve only the teachings of West.

5.

*Issue 5*

Has Appellant established that the Examiner erred in finding that West teaches "storing in the server system an available NAN list of NANs available for the client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list"?

*Analysis*

This limitation is found in claim 1 and is found in West for the reasons stated in connection with Issues 1 and 2.

*Conclusion - Issue 5*

Appellant has not established that the Examiner erred in finding that West teaches "storing in the server system an available NAN list of NANs available for the client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list."

6.

*Issue 6*

Has Appellant established that the Examiner erred in finding that West teaches "transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system"?

*Contentions*

The Examiner refers to Figures 2a-2c for this limitation. Final Rej. 19.

Appellant argues that the Examiner provides no explanation of how these figures meet the claim limitation. It is argued that the dialog boxes at Figures 2a-2c, which allow the username, password, and information as to where the user is calling from, are unrelated to the claimed feature and do not teach or suggest anything related to or similar to a NAN list. Br. 7.

The Examiner responds that the user can select a number in a NAN list, which is used to set up a connection procedure, and thus, transmits an identification of NANs in a NAN list. Ans. 43-44.

Appellant argues that the Examiner did not contest the logic of the arguments in the Appeal Brief. Reply Br. 3.

*Analysis*

It must first be understood what is being claimed. Transmitting an identification of the NANs in the user NAN list is said to correspond to the description in the Specification at page 20, line 21 to page 21, line 2. Br. 3-4. The Specification describes comparing the NANs in the available local NAN list with the NANs in the user NAN list to identify NANs in the available local NAN list, which are not in the user NAN list, which may be desirable to add, and to identify NANs in the user NAN list which are not in the available local NAN list, which the user may desire to delete. Spec. 20, ll. 20-21 to Spec. 21, l. 13. We interpret "transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system" to require transmitting an identity of all of the NANs in the user NAN list. It is noted that claim 12 does not claim doing anything with the information.

Figures 2a-2c describe how a remote user initiates a connection. The number selected is not transmitted to the online service provider but is used to dial into a PSTN. Even if it is assumed that the number is transmitted to the service provider, one number in a list is not "the NANs in the user NAN list." The Examiner does not rely on Dieterman for this feature. Thus, Appellant has shown err in the Examiner's rejection.

*Conclusion - Issue 6 and final conclusion*

Appellant has established that the Examiner erred in finding that West teaches "transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system." The rejection of claims 12-25 is reversed.

## CONCLUSION

The rejection of claims 1-11 under 35 U.S.C. § 102(e) over West is affirmed.

The rejection of claims 12-25 under 35 U.S.C. § 103(a) over West and Diederman is reversed.

The rejection of claims 30-32 under 35 U.S.C. § 103(a) over West and Diederman is affirmed.

Requests for extensions of time are governed by 37 C.F.R. § 1.136(b). *See* 37 C.F.R. § 41.50(f).

AFFIRMED-IN-PART

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